

REMARKS

Claims 7-28 are pending in this application. Claims 7, 11, 13, 16, 17, 18, 21, 25, 27, and 28 have been amended. The amendments are not narrowing because they provide antecedent basis and correct formal issues or conform to the usage of terms in the specification. No new matter has been added by virtue of this amendment to the claims. For the reasons below, Applicant respectfully requests entry of the amendment and reconsideration of the pending claims.

Rejections under 35 USC §112

In the Office Action, the Examiner rejected claims 7-28 under 35 U.S.C. 112 as failing to comply with the written description requirement. The Office Action argues that the claims contain subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventor possessed the invention as of the filing date of the invention. The Applicant respectfully traverses this rejection. The language at issue is "the step of extracting concepts comprises recognizing the identified groups of related mutually dependent relationships in which the related mutually dependent **relationships exceed a configurable threshold**.(emphasis added)" The language is a generalization of several concept extraction examples provided in the specification. The Office Action notes that page 5, lines 1-3 does not specifically describe the limitation. However, that statement is at least as detailed as the language in the claim. The difference in language is slight in that the language at page 5 does not discuss a "configurable" threshold as claim 7 does. However, all that the law requires is that "the applicant must . . . convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention." Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991). "Precisely how close the original description must come to comply with the description requirement of section 112 must be determined on a case-by-case basis." Eiselstein v. Frank, 52 F.3d 1035, 1039, 34 USPQ2d 1467,

1470 (Fed. Cir. 1995) (quoting Vas-Cath, 935 F.2d at 1561, 19 USPQ2d at 1116). Ipsis verbis disclosure is not necessary to satisfy the written description requirement of section 112. Instead, the disclosure need only reasonably convey to persons skilled in the art that the inventor had possession of the subject matter in question. In re Edwards, 568 F.2d 1349, 1351-52, 196 USPQ 465, 467 (CCPA 1978). In the instant case, the use of the additional word "configurable" simply means that the system can be configured to include a threshold. Those skilled in the art would recognize that the inventor clearly possessed an invention in which a concept is extracted if it is one in which the related mutually dependent relationships exceed a configurable threshold. Moreover, the examples in the specification illustrating extraction of concepts provide much more detail, further showing that the inventor possessed the claimed invention. For example, consider the example illustrated in FIG. 8, at page 25 a threshold is used to narrow down the characteristic concepts to be selected. Regarding claims 21 and 27-28 and 8-20 and 22-26, the above reasons also apply. With respect to claim 15, the fact that the specification describes a computer to carry out the claimed processes (see Fig. 14 for example) would convey to those skilled in the art that the selection of the threshold could be done automatically. Also, the discussion of providing a user interface would convey that the user can define the threshold. With respect to claim 17, the discussion of Figs. 6, 7 and 8 show that the inventors possessed this invention. As to claim 13, it has been amended to depend on claim 12, thus providing antecedent for "the category dictionary." For this reason, the Applicant respectfully requests withdrawal of the Examiner's rejection and allowance of these claims.

Rejections under 35 USC §103

In the Office Action, the Examiner rejected claims 7-28 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,857,179, issued to Vaithyanathan (hereafter "Vaithyanathan") in view of over U.S. Patent No. 6,006,221, issued to Liddy (hereafter "Liddy"). The Applicant respectfully traverses these rejections.

The Office Action argues that Vaithyanathan discloses the limitation of claim 7 of

"converting the received data into a common format" and cites col. 10, lines 43-50 and col. 5, lines 20-35 of Vaithyanathan. However, the cited discussion only relates to the cluster summary data and its display in a user-friendly interface and not to the conversion of the received collection of data and does not teach or suggest converting all data received into a common format. Col. 5, lines 20-35 show the format rules for the domain of the data received, not a conversion at all. There is no need to convert the input data in Vaithyanathan.

The Office Action argues that Vaithyanathan discloses the limitation of claim 7 of "combining the converted received data into clauses of related data" citing col. 5, lines 20-55, col. 10, and fig. 6a. However, that discussion does not relate to "clauses." The Office Action construes "clauses" unreasonably in applying it to this discussion. The claim language itself states "clauses of related data." The discussion cited discusses a database. All of the information in a database is not related. Although the patent office can give claim terms their broadest reasonable interpretation, equating a clause and a database is not reasonable.

The Office Action argues that Vaithyanathan discloses the limitation of claim 7 of "attempting to associate a category with each word within each of the clauses" citing col. 11, lines 1-5. The term matrix discussed does not appear to place each word in a clause in a category.

The Office Action argues that Vaithyanathan discloses the limitation of claim 7 of "identifying mutually dependent relationships between or among the categorized words, according to at least one rule defining mutually dependent relationships between or among categorized words" citing col. 11, lines 33-66. However, that is a discussion of a matrix of reduced dimensionality that does not appear to identify mutually dependent relationships as

claimed.

The Office Action concedes that Vaithyanathan does not disclose the limitation of claim 7 of "extracting [was identifying] concepts associated with the identified groups of related mutually dependent relationships, wherein the step of extracting concepts comprises recognizing the identified groups of related mutually dependent relationships in which the related mutually dependent relationships exceed a configurable threshold." However, the Office Action contends that U.S. Patent 6,006,221, issued to Liddy teaches the modification of the Vaithyanathan reference to include this step. Applicant respectfully traverses this conclusion.

Vaithyanathan is not properly combinable with Liddy, which relates to a multilingual document retrieval system, because there is no evidence that there was a suggestion, teaching, or motivation to combine the references. The problem addressed by Liddy is the difficulty of searching for foreign language documents satisfying a key word. The problem addressed by Vaithyanathan was scope of search terms (overly broad terms produced too many results and overly narrow terms not enough). Neither of those two different problems is the same as the problem faced by the inventor of the present application which is mining data from information such as customer complaints, problems and opinions. Therefore, those skilled in the art would not be motivated to combine Vaithyanathan and Libby to solve the problem faced by Applicant.

Moreover, the reasons cited by the examiner for combining the references is not supported by any evidence. Although "the suggestion more often comes from the teachings of the pertinent references," In re Rouffet, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998). That, however, does not diminish the requirement for actual evidence. That is, the showing must be clear and particular. See, e.g., C.R. Bard, Inc. v. M3 Sys., Inc., 157 F.3d 1340, 1350, 48 USPQ2d 1225, 1352 (Fed. Cir. 1998). Broad conclusory statements regarding the

teaching of multiple references, standing alone, are not "evidence." E.g., McElmurry v. Arkansas Power & Light Co., 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993) ("Mere denials and conclusory statements, however, are not sufficient to establish a genuine issue of material fact."); In re Sichert, 566 F.2d 1154, 1164, 196 USPQ 209, 217 (CCPA 1977) ("The examiner's conclusory statement that the specification does not teach the best mode of using the invention is unaccompanied by evidence or reasoning and is entirely inadequate to support the rejection."). In addition to demonstrating the propriety of an obviousness analysis, particular factual findings regarding the suggestion, teaching, or motivation to combine serve a number of important purposes, including: (1) clear explication of the position adopted by the Examiner and the Board; (2) identification of the factual disputes, if any, between the applicant and the Board; and (3) facilitation of review on appeal. In re Zurko, 258 F.3d 1379 (Fed. Cir. 2001). In the instant case, the Office action cited Liddy as saying that "for the purpose of disambiguating the related words" as being one motivation. However, that is not a proper motivation because in Liddy that relates to words having multiple meanings including in different languages. The Office Action further states that it would have been obvious to combine the references for "finding highly relevant documents for searching." However, that problem is a highly general statement that ignores that ignores the cited portion ("The invention, by abstracting the documents and queries into language independent form, avoids the need for machine translation of the query or the database.") and if that were a proper motivation the test for combination would be so easy to meet that only very few inventions would be patentable.

Even if the references were combinable (which Applicant contests), the combination still lacks at least the last element. The search engine of Libby automatically searches for the conceptual level of the document and the query. Applicant respectfully submits that Liddy neither teaches nor suggests the claimed limitation of extracting a concept. A "concept" is defined in the specification as a "key word" with a "category" assigned. See specification at page 7. The claim must be considered as a whole. That is especially true in a claim as method claim 7 wherein input data is processed in each step to extract the concept. It is indeed remarkable that the Office Action contends that Vaithyanathan teaches all but the last step but it is more remarkable that the Liddy reference teaches the last step even though it did not do the

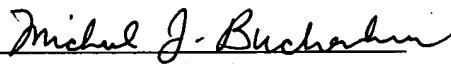
prior steps (or it would have been an anticipatory reference).

Liddy does not deal with the claimed "concepts" at all. The discussion cited uses the words "concept group" but this has nothing to do with the claimed concepts. The concept group is a category assigned to a polysemous word. The concept groups are stored in a multilingual concept database for all those input words for which multiple concept group tags have been received. Col. 11, lines 38-41. That is completely different from the claimed concept that is extracted from a highly filtered and processed input data (related mutually dependent relationships).

Claims 8-20 are dependent on claim 7 and are patentable for at least the foregoing reasons. Claim 21 is an article of manufacture counterpart of claim 21 and is patentable for at least the foregoing reasons. Claims 22-26 are dependent on claim 21 and are patentable for at least the foregoing reasons. Claim 27 is a system counterpart of claim 1 and is patentable for at least the foregoing reasons. Claim 28 is a service counterpart of claim 1 and is patentable for at least the same reasons as claim 1.

For the foregoing reasons, Applicant respectfully requests entry of the amendment and allowance of the pending claims.

Respectfully submitted,

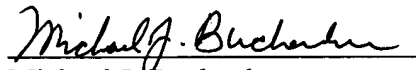

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I hereby certify that this Amendment and Response to Office Action, and any documents referred to as attached therein are being deposited with the United States Postal Service as First Class Mail on this date, November 10, 2005, to the Commissioner for Patents, U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450.


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